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09/478,051	01/15/2000	MICHAEL J. PICCIALLO	73348.00008	1136
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EXAMINER				
KUCAB, JAMIE R				
ART UNIT		PAPER NUMBER		
3621				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

Office Action Summary

Application No.

09/478,051

Applicant(s)

PICCIALLO, MICHAEL J.

Examiner

JAMIE KUCAB

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 75, 78-83, 85, 87, 99, 111, 112 and 114 is/are pending in the application.
- 4a) Of the above claim(s) 111 and 112 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 75, 78-83, 85, 87, 99 and 114 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/35/08)
Paper No(s)/Mail Date 10/27/10
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Applicant's response filed October 27, 2010 is acknowledged.
2. Claims 75, 78-83, 85, 87, 99, 111, 112, and 114 are pending in the application.
3. Claims 111 and 112 are withdrawn from consideration.
4. Claims 75, 78-83, 85, 87, 99, and 114 are examined below.
5. This Office action is given Paper No. 20101031 for reference purposes only.

Priority

6. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. §119(e) or under 35 U.S.C. §§ 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. §120 as follows:
 7. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. §112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).
8. The disclosure of the prior-filed application, Application No. 08/585,173, fails to provide adequate support or enablement in the manner provided by the first paragraph

of 35 U.S.C. 112 for one or more claims of this application. 08/585,173 fails to provide the necessary support for such limitations as “computer-based” of the independent claims 75 and 99 and “encoding a debit card linked to said third party account with third party account information permitting cash withdrawals or fund transfers as payments for goods or services” of independent claim 99.

Claim Objections

9. Claim 85 is objected to because of the following informalities: where Applicant recites “wherein money transferred,” it appears that Applicant intends to recite -- wherein said money is transferred -- or similar. For the purpose of comparison with the prior art, the Examiner is taking it as such.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 75, 78-83, 85, 87, 99, and 114 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

12. Based upon consideration of all of the relevant factors with respect to the claims as a whole, claims 75 and 99 are held to claim an abstract idea, and are therefore rejected as ineligible subject matter under 35 U.S.C. § 101. The rationale for this finding is explained below: These claims fail the machine-or-transformation test, because the claimed methods are not tied to a particular machine (or apparatus) nor do

the methods transform underlying subject matter (such as an article or materials) to a different state or thing. Although claims 75 and 99 recite that the methods are "computer-based," this is merely a field-of-use limitation that is insufficient to render the claims patent-eligible. Although claim 99 recites "encoding a debit card," this is a form of data output, and such extra-solution activity is insufficient to tie the method to a particular machine. Therefore, claims 75 and 99 encompass non-statutory subject matter and are rejected accordingly.

13. The claims dependent from claims 75 and 99 when analyzed as a whole are held to be ineligible subject matter and are rejected under 35 U.S.C. § 101 because the additional recited limitations fail to establish that the claim is not directed to an abstract idea, as detailed below: These claims fail the machine-or-transformation test, because the claimed methods are not tied to a particular machine (or apparatus) nor do the methods transform underlying subject matter (such as an article or materials) to a different state or thing. Therefore, the claims dependent from claims 75 and 99 fail to make the process statutory, and they are rejected accordingly.

Claim Rejections - 35 USC § 112, Second Paragraph

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 75, 78-83, 85, 87, and 114 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

16. Regarding claim 75, Applicant's recitation "said information on payees and corresponding payment amounts for said third party account" would have been unclear to a person having ordinary skill in the art at the time of the invention. It is unclear what information is being referred to. The only previously introduced "information" is that which is supplied by the fund depositor in creating the account, which is presumably not information on payees and corresponding payment amounts. For the purpose of comparison with the prior art only, the Examiner is interpreting "said information" to be -- information -- consistent with claim 99. Appropriate correction is required.

17. Regarding claim 75, Applicant's recitation "said fund depositor account" would have been unclear to a person having ordinary skill in the art at the time of the invention. There is no antecedent basis for this recitation. It is unclear whether "said fund depositor account" refers to a previously-introduced account or is a new account. For the purpose of comparison with the prior art only, the Examiner is interpreting "said fund depositor account" to be -- fund depositor account -- consistent with claim 99. Appropriate correction is required.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

19. Claims 75, 77, 99, and 101, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Fleming et al. (US Patent 5,953,710, hereafter, "Fleming").
20. Regarding claim 75, Fleming discloses a computer-based method comprising:
- a. creating a third party account ("a child's credit card account," Abstract) using information received from a fund depositor ("linked to a parent's credit or debit card account," Abstract);
 - b. establishing a periodic and automatic transfer of money into said third party account from said fund depositor account ("When the parent selected allowances, they would be prompted by the Bank Telecom Interface 62 to enter the allowance amount and the periodic interval of the allowance, such as weekly." C14 L55-58); and
 - c. supplying to said fund depositor information on payees ("Merchant/Info," Fig. 2A) and corresponding payment amounts ("Amount," Fig. 2A) for said third party account (see Fig. 2A showing that child transactions are a subset of the data provided on the Parent Statement List 56).
21. Regarding claim 99, Fleming discloses a computer-based method comprising:
- d. creating a third party account ("a child's credit card account," Abstract) with a bank linked to an account of a fund depositor using information received

from said fund depositor ("linked to a parent's credit or debit card account," Abstract);

e. encoding a debit card ("Children's Credit Card 4," Fig. 1; the child's card can also be a debit card, C13 L24-36) linked to said third party account ("linked to a parent's credit or debit card account," Abstract) with third party account information permitting cash withdrawals or fund transfers as payments for goods or services ("The children's credit card system is used for purchases in exactly the same way as other credit cards," C16 L41-42);

f. issuing said debit card to a designated recipient of said fund depositor ("Credit and debit cards are issued to individuals or entities by banks and others," C1 L15-16, "mailing addresses may be different," C5 L44-45); and

g. supplying to said fund depositor information on payees ("Merchant/Info," Fig. 2A) and corresponding payment amounts ("Amount," Fig. 2A) for said third party account (see Fig. 2A showing that child transactions are a subset of the data provided on the Parent Statement List 56).

22. Regarding claims 77 and 101, Fleming further discloses wherein said bank or credit card account for said fund depositor is a new account ("create a new parent's account number," C6 L3-4).

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

24. Claims 78-83, 85, 87, 102-107, 110, and 114, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming in view of Langhans et al. (US Patent 5,500,513, hereafter "Langhans").

25. Regarding claims 78-81, 87, 102-105, and 110, Fleming discloses as above, however, Fleming fails to explicitly disclose the steps of:

- a. limiting the amount of funds in said third party account that may be spent using said magnetic card on particular classes of goods and services using information entered by said fund depositor with a personal computer;
- b. verifying a fund transfer requested by said third party recipient using said magnetic card to determine whether said funds requested exceed the limit set for the goods or services to be purchased;
- c. wherein said goods or services comprise books, computer software, food, lodging or entertainment;
- d. wherein said limit is a periodic limit; and
- e. wherein said step of limiting the classes of goods and services on which funds in a third party account may be spent comprises prohibiting the withdrawal of cash or spending on alcohol or tobacco.

26. However, Langhans teaches:

- a. limiting the amount of funds in said third party account that may be spent using said magnetic card on particular classes of goods and services using

information entered by said fund depositor with a personal computer ("The present invention also allows a company to group merchant category codes in order to limit purchases to those merchant types which would be needed by a particular department or individual." C2 L37-40);

b. verifying a fund transfer requested by said third party recipient using said magnetic card to determine whether said funds requested exceed the limit set for the goods or services to be purchased ("A test 126 determines whether the Standard Industrial Classification (SIC) code of the merchant is acceptable for the account. If it is not, the request will be declined." C7 L55-58);

c. wherein said goods or services comprise books, computer software, food, lodging or entertainment ("a salesperson could be allowed a velocity checking limit for the category of hotels at a high frequency level, while an accounting clerk with no reason to travel could be allocated a lower velocity level, or allocated no authorization for hotels at all." C2 L12-17);

d. wherein said limit is a periodic limit ("Test 138 allows a spending limit to be applied over a company-defined cycle, such as a monthly cycle or other billing cycle." C8 L9-11); and

e. wherein said step of limiting the classes of goods and services on which funds in a third party account may be spent comprises prohibiting the withdrawal of cash or spending on alcohol or tobacco ("control cash advances," C13 L27-28).

27. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method of Fleming to include the limiting step, verifying step, merchant categories, periodic limit, and controlling cash advances of Langhans in order to achieve the predictable result of giving the parent greater flexibility in the control of the child's spending.

28. Regarding claims 82 and 106, Fleming further discloses wherein said stored information on payees and corresponding payment amounts for said third party account is automatically supplied to said fund depositor ("Fig. 2a depicts a parent statement list 56 which is used to generate a monthly statement for the parent's credit card." C7 L25-26).

29. Regarding claims 83 and 107, Fleming further discloses wherein said supplying step is performed periodically ("Fig. 2a depicts a parent statement list 56 which is used to generate a monthly statement for the parent's credit card." C7 L25-26).

30. Regarding claim 85, Fleming further discloses wherein said money is transferred weekly or monthly ("When the parent selected allowances, they would be prompted by the Bank Telecom Interface 62 to enter the allowance amount and the periodic interval of the allowance, such as weekly," C14 L55-58).

31. Regarding claims 79 and 114, the combination Fleming/Langhans teaches permitting purchases from a computer software store or a bookstore in that neither reference discloses preventing such purchases.

Double Patenting

32. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
33. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.
34. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

35. Claims 75, 78-83, 85, 87, 99, and 114 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 7,653,595. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ merely in terminology. Those limitations not explicitly disclosed in the claims of the '595 patent would be obvious in view of the claims of the '595 patent and either Langhans or Fleming.

Response to Arguments

36. Applicant's arguments filed October 27, 2010 have been fully considered, but they are only partially persuasive.

37. The §112, 1st and 2nd paragraph rejections of the previous Office action have been withdrawn in response to Applicant's amendments.

38. Regarding the previous §103 rejections of the claims, Applicant argues that Fleming is not prior art, because the CIP ancestor Application 08/876,929 antedates Fletcher's filing date. Remarks, pgs. 10-11. The Examiner must respectfully disagree. The '173 application lacks any mention of a computer, and, therefore, lacks support for the claimed "computer-based" methods. Priority to the '173 application is denied as discussed above. The Fleming reference is still prior art relative to the instant application.

39. Applicant further argues that Fleming discloses only credit limits and periodically increasing available credit limits, and, therefore, does not disclose an allowance. Remarks, pg. 11. The Examiner must respectfully disagree. Fleming also discloses the

use of debit cards: "The available credit balance for a debit card account then corresponds to the available account balance in the debit card account." C12 L60-62. Fleming, therefore, discloses periodic transfers of money ("account balance"), not merely available credit, and, therefore, discloses or makes obvious Applicant's invention as detailed above.

40. Applicant further alleges that there is no motivation to combine Langhans with Fleming (pg. 11), but gives no reasoned argument as to why one of ordinary skill would lack motivation to make such a combination, nor does Applicant offer any reason as to why the Examiner's rationale for combining the references is in error.

41. In response to applicant's arguments against Langhans individually (pgs. 11-13), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

42. For the above reasons, the prior art rejections of the previous Office action are maintained as modified above in response to Applicant's amendments.

43. Regarding the double patenting rejections, Applicant references a terminal disclaimer being filed in conjunction with the response (pg. 14), however, no terminal disclaimer could be found in the file wrapper as of October 31, 2010. The double patenting rejections will be withdrawn when an appropriate terminal disclaimer is filed and approved.

Conclusion

44. Applicant's amendment filed October 27, 2010 necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

45. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

46. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that--suggestions or examples--and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a

claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not* been addressed with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

47. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

48. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

49. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jamie Kucab/

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